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A.J.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/351,051	07/10/99	THOMAS C	CDTP001B

LMC1/0211

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EXAMINER	
HECKLER, T	
ART UNIT	**PAPER NUMBER**
2787	2

DATE MAILED: 02/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/351,051	THOMAS
Examiner	**Group Art Unit**
Hecker	2787

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 (Three) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Notice of References Cited, PTO-892

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

1. Claims 12-15, 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Since these are the same claims as originally presented in parent case 08/262,754, these claims are rejected for reasons given in paper no. 4 (3/1/96), paragraph 1 of application 08/262,754.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 7, 11, 12 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Nakai (Japanese Patent 5224773).

This reference is cited for reasons given in paper no. 7 (7/9/96), paragraph 2 of application 08/262,754.

4. Claims 1-3, 7, 11, 12, 18 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by either of Kikinis (5,502,838) or Neal et al (5,483,102).

Each of these references teach varying the frequency of a clock signal to a microprocessor depending on the temperature of the microprocessor.

5. Claims 6, 8, 13, 20 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Neal et al (5,483,102).

This reference is cited for reason s given in paragraph 4 above. Neal also teaches controlling a fan in accordance with the microprocessor temperature and the use of a voltage-controlled oscillator for the clock.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakai.

This reference is cited for reasons given in paper no. 7 (7/9/96), paragraph 4 of application 08/262,754.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakai in view of Fairbanks et al (5,021,679).

These references are cited for reasons given in paper no. 7 (7/9/96), paragraph 5 of application 08/262,754.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakai in view of Kenny et al (5,287,292).

These references are cited for reasons given in paper no. 7 (7/9/96), paragraph 6 of application 08/262,754.

10. Claims 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Kikinis (5,502,838) or Neal et al (5,483,102).

These references are cited for reasons given above in paragraph 4. Although it is not taught that the temperature sensor is integral with the circuitry of the processor or that the processor (computer) is a portable computing device, it is a

skill of the art that both these features are easily realized since integration of elements is cost effective and a space saving means, and portable computing devices are well known.

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 1, 4 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 21, 22 of prior U.S. Patent No. 5,974,557. This is a double patenting rejection.

13. Claims 6, 9, 10, 14, 18 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 6, 9, 10, 23, 30 of prior U.S. Patent No. 5,752,011. This is a double patenting rejection.

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 16, 17 are rejected under the judicially created doctrine of double patenting over claim 31 of U. S. Patent No. 5,752,011 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: monitoring chip temperature of a microprocessor and changing clock frequency depending on chip temperature and one clock frequency is an overdrive clock

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the

instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

16. No copies of the prior art have been provided since these references were provided or cited by applicant in the parent applications.

17. This is a continuation of applicant's earlier Applications No. 08/914,299 and 08/262,754. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Heckler whose telephone number is (703) 305-9666.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 305-3900.

TH
February 10, 2000

THOMAS M. HECKLER
PRIMARY EXAMINER